



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/476,711      | 12/30/1999  | DAVID O. MCGOVERAN   |                     | 8198             |

7590 12/28/2005  
GEORGE S COLE  
495 SEAPORT COURT SUITE 101  
REDWOOD CITY, CA 94063

EXAMINER

BOYCE, ANDRE D

ART UNIT PAPER NUMBER

3623

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,711

Applicant(s)

MCGOVERAN, DAVID O.

Examiner

Andre Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 112-192 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 112-192 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2005 has been entered.
2. Claims 31-111 have been canceled. Claims 112-192 have been added and are pending.
3. The previously pending objection to the specification has been withdrawn.  
The previously pending objections to claims 33 and 39-43 have been withdrawn, as moot, since the claims have been canceled.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 112-192 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 112 recites the limitations "the satisfaction", "the occurrence", and "said dynamic process" in lines 30, 31, and 34, respectively, of the claim. There is insufficient antecedent basis for this limitation in the claim. Claims 113-190 are rejected based upon the same rationale.

Claim 191 recites the limitation "said dynamic process" in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 192 recites the limitations "the satisfaction", "the occurrence", and "said dynamic process" in lines 37, 38, and 40, respectively, of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 192 also recites the limitation "the steps of declaring, stating, delegating, determining, and modifying" in line 14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 112-192 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In order to be considered useful, the claimed invention must possess a practical application. In order to be concrete, the result

Art Unit: 3623

must be assured and reproducible. In order to be tangible, the result must involve more than a manipulation of an abstract idea.

In the present case, independent claims 112, 191, and 192 provide no useful result. Claim 112 recites declaring and stating an objective, declaring and stating at least one objective rule set, delegating to at least one specific set of actors, determining the satisfaction of an rule's condition, modifying at least on element, etc. However, these limitations provide no practical application, thus the claim does not provide a useful result, and is deemed to be non-statutory. Claims 113-190 are rejected based upon the same rationale. Claim 191 recites specifying a set of at least two ordered rules, wherein the dynamic process is the set of possible conditions and actions. These limitations provide no practical application, thus the claim does not provide a useful result, and is deemed to be non-statutory. Claim 192 recites means for accepting, comparing, delegating, determining, modifying, etc. However, these limitations provide no practical application, thus the claim does not provide a useful result, and is deemed to be non-statutory.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 191 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tinnirello (Project Management, July 1999), in view of Davis et al (The Information System Consultant's Handbook, December 1998).

As per claim 191, Tinnirello discloses a computer-implemented business method for actively and declaratively managing, implementing, and executing a first dynamic process (e.g., project management, pg 3), comprising: specifying a set of at least two ordered Rules (i.e., at least two related tasks, including determination of task inter-dependencies, page 4-5), wherein the Action of a first Rule triggers the Condition of a second Rule (i.e., inter-dependency of tasks trigger successor tasks, page 4-5), and all Rules in the set form a partially ordered set wherein Actions of preceding Rules trigger Conditions of subsequent Rules (i.e., set of predecessor and successor tasks, page 4-5), wherein said dynamic process is the set of possible Conditions and Actions of said partially ordered set of Rules (i.e., set of tasks and corresponding relationships, page 4-5). Tinnirello does not explicitly disclose incorporating a dynamic pattern of operations driven by real-world conditions, through which at least a first behavioral pattern emerges.

Davis discloses incorporating a dynamic pattern of operations driven by real-world conditions, through which at least a first behavioral pattern emerges (i.e., creation of an expert system, page 49). Both Tinnirello and Davis et al are concerned with effective project management, wherein Tinnirello teaches management of large scale IS projects (pg 99), therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include

Art Unit: 3623

incorporating a dynamic pattern of operations driven by real-world conditions, through which at least a first behavioral pattern emerges in Tinnirello, as seen in Davis et al, as effective means of determining contradictions and modifying rules as a result, thereby making the project management in Tinnirello more flexible and robust.

### ***Allowable Subject Matter***

10. Claims 112-190 and 192 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

11. In the Remarks, Applicant argues In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Davis discloses that a project management life cycle is similar to a system development life cycle, with stages or phases defining a

schedule and triggering resource allocations, thus providing a framework or structure for the tools used in information system development (page 4).

In response to Applicant's argument that Tinnirello and Davis are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Tinnirello (i.e., project management) and Davis (i.e., system development) are indeed extremely pertinent to the Applicant's problem of managing a business' operational flow (see claim 115).

The Examiner also notes that the date of the Tinnirello reference is July 1999, making it a valid 35 USC § 102(a) reference.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

adb  
December 22, 2005

  
ANDRE BOYCE  
PATENT EXAMINER  
AU 3623